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BLACK LOWE & GRAHAM, PLLC 701 FIFTH AVENUE SUITE 4800 SEATTLE, WA 98104			XU, LING X	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,206

Applicant(s)

SCHOBER, DENNIS A.

Examiner

Ling X. Xu

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 40-91 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-17, 19 and 40-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants' amendments filed on 10/31/2005 have been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 5-17 and 40-91 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1-2, 5-17 and 40-91, the Examiner maintains that the specification does not support or sufficiently describe "a thermoplastic non-copolyester polymeric material" recited in the claims. The specification only limits the polymeric material to be selected from the group consisting of polymethylmethacrylate, polyvinyl chloride, polycarbonate and combinations thereof. The thermoplastic non-copolyester polymeric material as recited includes much broader scope of the polymeric materials than what is disclosed in the specification of the present application and therefore, the recitation includes new matters.

Art Unit: 1775

In claims 13-15, the recitation of “an envelope encompassing the visible object” is not supported by or sufficiently described in the specification.

In the response filed on 10/31/2005, Applicant fails to indicate the page and line numbers where support is found or clearly explain how the limitations stated above are derived from the original disclosure.

In claims 47-48, 53, 55, 65, 67, 76, 78, 85 and 87, the limitations of the sink being “bowl-shaped” and the lavatory including a “bowl-shaped basin” are not supported by or sufficiently described in the specification.

In the response filed on 10/31/2005, Applicant argues that the sink and lavatory inherently have the bowl-shaped. It is unclear if the applicant’s intension is to limit the sinks and lavatories to be bowl-shaped only. Please clarify.

In addition, the newly added limitations in claims 1, 7, 10, 13 and 16 are also not supported by or sufficiently described in the specification for the following reasons:

As indicated by the applicant, the specification describes that the polymer sheets may vary in thickness from about 0.004 to 1.0 inch and some of the decorative materials may have a thickness of up to 1.0 inch. However, there is no description in the specification regarding the relation between the specific thickness of the decorative material and the polymer sheets as recited in the claims, which includes that the decorative material is greater than 25 percent of the thickness of the polymer material as recited in claim 1, or greater than 50 percent of the thickness

Art Unit: 1775

of the polymer material as recited in claim 7, or the polymer material having thickness less than two times that of the visible decorative objects as recited in claim 13.

Even if the specification discloses the polymer sheets have thickness from about 0.004 to 1.0 inch and the decorative materials may have a thickness of up to 1.0 inch. These thickness ranges do not support the limitations recited in claims 1, 7 and 13. For example, the decorative material may have a thickness of 0.20 inch, the polymer sheet may have a thickness of 1.0 inch. In this case, the thickness of the decorative material is clearly not greater than 25 percent of the thickness of the polymer material as recited in claim 1, or greater than 50 percent of the thickness of the polymer material as recited in claim 7, or the thickness of the polymer material is not less than two times that of the visible decorative objects as recited in claim 13.

In claim 10, there is also no support from the specification that the decorative object is porous.

In claim 16, there is also no support from the specification that the decorative material having an area substantially greater than 90 percent that of the first and second sheets.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, it recites that the unitary matrix is non-porous which comprising a porous decorative object. It is unclear if the unitary matrix is porous or non-porous. Since the specification does not support the decorative layer being porous but recites that the matrix is non-porous. Therefore, the following examination is based on that the matrix as a whole is non-porous.

***Claim Rejections - 35 USC § 102***

4. Claims 1-2, 5-6, 16-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Theil et al. (US 5,837,091).

With respect to claims 1-2, 5, 16-17 and 19, Theil discloses a flat laminated polymethacrylate plastic comprising a flat or oblong object such as pictures, film filaments, fabric strips, wires or steel spirals embedded into the laminates for decorative display such as advertising display (col. 5, lines 55-67).

Theil also discloses that the laminating decorative objects having a thickness that is less than 50% that of the upper and lower sheets forming sheets (col. 5, lines 15-25), which is within the range as recited in claim 1.

With respect to claim 6, Theil discloses the polymethacrylate plastic parts are sheets which have engravings or embossings (col. 2, lines 55-60)

It is noted that claims 1-2, 5-6, 16-17 and 19 are product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps (MPEP 2113). “[E]ven though product – by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The

Art Unit: 1775

patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966. The extension of the decorative object at the edge of the matrix was trimmed at the end of the process (see page 16 of the specification). Accordingly, the finished solid surface structure would not have the decorative object that extends to the edge of the matrix.

With respect to the newly added limitations in claim 16, it should be noted that, as stated above, the specification does not support the limitations that the decorative object covering substantially more than 90% of the area of the sheets forming the matrix. Also, since the extension of the decorative object at the edge of the matrix was trimmed at the end of the process. The finished solid surface structure would not have the decorative object that extends to the edge of the matrix or have the area substantially greater than 90% of the first and second sheets after the extension of the decorative object at the edge of the matrix was trimmed.

5. Claims 7-9, 13-15, 49-50 and 72-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theil et al. (US 5,837,091) as applied to claims 1-2, 5-6, 16-17 and 19 above, and further in view of the same reference Theil et al. (US 5,837,091).

As stated above, Theil discloses the same non-porous unitary solid surface structure as recited in claims 1-2, 5-6, 16-17, 19, including the limitations recited in claims 8-9, 14-15, 49-50 and 72-73.

Art Unit: 1775

Theil also discloses that the laminating decorative objects having a thickness that is less than 50% that of the upper and lower sheets forming sheets (col. 5, lines 15-25), which is very similar to the claimed range recited in claims 7 and 13.

It has been well settled that overlapping ranges have been found to be obvious variants without the support of unexpected results. *In re Wertheim*, 541 F.2d 257, 191USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed.Cir. 1990), also see MPEP 2144.05. Similarly, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of “having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium” as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.). It is the Examiner’s position that the range of less than 50% is very similar to the claimed range recited in claims 7 and 13.

When the claimed range and the prior art range are very similarly, the range of the prior art establishes *prima facie* obviousness because one of ordinary skill in the art would have expected the similar ranges to have the same properties. *See in re Peterson*, 65 USPQ2d 1379, 1382, citing *titanium Metals Corp. V. Banner*, 227 USPQ 773, 779. Furthermore, the disclosure by the reference of a preferred embodiment does not teach away from the entire disclosure of the patent, all of which must be considered in the analysis of obviousness. *See In re Burckel*, 201 USPQ 67, 70.



Art Unit: 1775

Therefore, it would have been obvious to one of ordinary skill in the art to make and use the decorative laminate with the thickness range as claimed because one of ordinary skill in the art would have expected the similar ranges to have the same properties.

6. Claims 10-12 and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theil as applied to claims 1-2, 5-9, 13-17, 19, 49-50 and 72-73 above, and further in view of the same reference.

As stated above, Theil discloses the same non-porous unitary solid surface structure as recited in claims 1-2, 5-6, 16-17, 19, including limitations in claims 11-12 and 60-62.

Theil does not disclose that the laminate comprising the additional sheet of second thermoplastic material and additional visible decorative object layer as recited in claim 10.

However, the additional layers recited are simply the duplicates of the laminate structure disclosed by Theil.

It has been held that mere duplication of the essential working parts of a structure involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8. The court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced, *see* MPEP 2144.04 VI B.

Therefore, absent of showing unexpected results, it would have been obvious to one of ordinary skill to make multilayer of laminate structure by simply duplicating the same structure disclosed by Theil in order to provide more visible effects.

Art Unit: 1775

7. Claims 1-2, 5-9, 13-17, 40-59 and 63-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart et al (5,894,048) in view of Kaetsu et al. (US 4,138,300).

With respect to claims 1-2, 5-17, 19, 13-15 and 72-73, Eckart discloses a decorative laminate comprising a decorative image such as printed or colored film layer permanently fixated between the thermoplastic polymeric material layers. The laminate is also considered to have an envelope shaped.

Eckart also discloses the surface of the polymeric material is embossed or textured.

Eckart also discloses that the decorative layer is about 0.025 - 0.254mm (col. 3, lines 20-24) and the polymeric layer is about 0.13 mm to about 12.7 mm thick. A decorative layer having a thickness 0.25 mm and the polymeric layer having a thickness of 0.4 mm is within the thickness range as stated above. In this case the decorative film is greater than 50% of the polymeric layer, which meets the limitations of claims 1, 7 and 13.

With respect to claims 40-48, 51-59, 63-71 and 74-91, Eckart discloses the solid surface comprising the laminate is used as a building material such as counter tops, table tops, hot tubs sink, soap dish (col. 8, lines 55-65).

It is noted that claims 1-2, 5-9, 13-17, 40-59 and 63-91 are product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps (MPEP 2113). “[E]ven though product – by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re*

Art Unit: 1775

*Thorpe*, 227 USPQ 964, 966. The extension of the decorative object at the edge of the matrix was trimmed at the end of the process (see page 16 of the specification), accordingly, the finished solid surface structure would not have the decorative object that extends to the edge of the matrix.

With respect to the newly added limitations in claim 16, it should be noted that, as stated above, the specification does not support the limitations that the decorative object covering substantially more than 90% of the area of the sheets forming the matrix. Also, since the extension of the decorative object at the edge of the matrix was trimmed at the end of the process. The finished solid surface structure would not have the decorative object that extends to the edge of the matrix or have the area substantially greater than 90% of the first and second sheets after the extension of the decorative object at the edge of the matrix was trimmed.

Eckart does not disclose the thermoplastic is polymethylmethacrylate.

Kaetsu teaches the use of polymethylmethacrylate in a wide variety of applications such as interior decoration, displays, building materials because it is less expensive and has improved transparency, appearance, impact resistance, and weather resistance (col. 1, lines 10-30).

Therefore, it would have been obvious to one of ordinary skill in the art to use polymethylmethacrylate as the thermoplastic material in Eckart's decorative laminate because it's less expensive and has improved transparency, appearance, impact resistance, and weather resistance, as taught by Kaetsu.

Art Unit: 1775

8. Claims 10-12 and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart et al and Kaetsu et al., as applied to claims 1-2, 5-9, 13-17, 40-59 and 63-91 above, and further in view of the same reference.

As stated above, Eckart and Kaetsu disclose the same non-porous unitary solid surface structure as recited in claims 1-2, 5-9, 13-17, 40-59 and 63-91.

Eckart and Kaetsu do not disclose that the laminate comprising the additional sheet of second thermoplastic material and additional visible decorative object layer as recited in claim 10.

However, the additional layers recited are simply the duplicates of the laminate structure disclosed by Theil.

It has been held that mere duplication of the essential working parts of a structure involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8. The court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced, *see* MPEP 2144.04 VI B.

Therefore, absent of showing unexpected results, it would have been obvious to one of ordinary skill to make multilayer of laminate structure by simply duplicating the same structure disclosed by Eckart and Kaetsu in order to provide more visible effects.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart et al and Kaetsu et al., as applied to claims 1-2, 5-9, 13-17, 40-59 and 63-91 above, and further in view of Theil et al (US 5,837,091).

Art Unit: 1775

As stated above, Eckart and Kaetsu disclose the same non-porous unitary solid surface structure as recited in claims 1-2, 5-9, 13-17, 40-59 and 63-91.

Eckart and Kaetsu do not disclose that the decorative material is a textile.

However, using textile as the decorative material is well known in the art and not the invention of the present application. For example, Theil teaches the use of fabric strips as the decorative material. Therefore, it would have been obvious to one of ordinary skill in the art to use textiles material as the decorative material for the specific visible effects provided by the textile materials.

#### ***Response to Arguments***

10. Applicant's arguments filed 11/2/2005 have been fully considered but they are not persuasive.

With respect to rejection under 35 USC 112(1), Applicant arguments are addressed in the rejections above.

With respect to the rejection based on reference Theil, Applicant argues that Theil does not disclose the decorative object has a thickness as claimed. The Examiner disagrees.

As stated above, Theil clearly discloses that the laminating decorative objects having a thickness that is less than 50% that of the upper and lower sheets forming sheets, which meets the claimed limitations of greater than 25% and less than or equal to 100% as recited in claim 1.

As also stated above, the thickness range disclosed by Theil is very similar to the claimed range recited in claims 7 and 13 and a prima facie case of obviousness exists where the claimed

Art Unit: 1775

ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties.

Applicant also argues that the method disclosed by Thei et al. is incapable of forming products having the disclosed proportion of sheet and decorative object thickness. The Examiner disagrees.

The claimed subject matter of the claims is directed to a product not a method. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966.

The arguments of counsel cannot take the place of evidence in the record. Applicant should provide evidence to show that the product made by the method disclosed by Theil is a different product from the product made by the method disclosed in the present application.

Applicant also argues that the limitations recited in claims 1, 7 and 13 are fully supported by the specification. The Examiner disagrees for the reason set forth in the 35 USC 112(1) rejections stated above.

With respect to claims 10 and 16, applicant argues that Theil fails to disclose a matrix comprising a decorative object extending over the entire sheet to each edge of the matrix or covering substantially more than 90% of the area of the sheets forming the matrix.

Art Unit: 1775

First, the specification does not support the limitations that the decorative object covering substantially more than 90% of the area of the sheets forming the matrix.

As stated in the prior Office action, since the extension of the decorative object at the edge of the matrix was trimmed at the end of the process. The finished solid surface structure would not have the decorative object extends to the edge of the matrix or have the area substantially greater than 90% of the first and second sheets after the extension of the decorative object at the edge of the matrix was trimmed.

With respect to the rejection under 35USC 103(a), Applicant argues that Theil does not enable the laminate disclosed because the method disclosed by Theil does not disclose how it may be performed in a multi layer embodiment as recited in claim 10.

Again, the claimed subject matter of the claims is directed to a product not a method. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966.

The arguments of counsel cannot take the place of evidence in the record. Applicant should provide evidence to show that the product made by the method disclosed by Theil is a different product form the product made by the method disclosed by the present application.

With respect to references Eckart and Kaetsu, Applicant argues that Eckart discloses the proportion of sheet thickness and decorative object thickness recited in claims 1, 7 and 13.

Art Unit: 1775

As stated above, Eckart clearly discloses that the decorative layer is about 0.025-0.254mm (col. 3, lines 20-24) and the polymeric layer is about 0.13 mm to about 12.7 mm thick. Accordingly, if the decorative layer having a thickness 0.25 mm and the polymeric layer having a thickness of 0.4 mm (which are within the thickness range as disclosed by Eckart as stated above), the decorative film is greater than 50% of the polymeric layer, which meets the limitations of claims 1, 7 and 13.

With respect to claim 10, Applicant argues that Eckart and Kaetsu whether alone or in combination, fails to disclose a decorative layer that is both porous and extends over the entire area of the sheets forming a laminate.

First, the specification does not support the decorative layer being porous but recites that the matrix is non-porous. Therefore, the matrix as a whole, which including the decorative layer, is considered non-porous.

Also, as stated in the prior Office action, since the extension of the decorative object at the edge of the matrix was trimmed at the end of the process. The finished solid surface structure would not have the decorative object extends to the edge of the matrix or have the area substantially greater than 90% of the first and second sheets after the extension of the decorative object at the edge of the matrix was trimmed.

Applicant also argues that Theil fails to teach or suggest extending decorative objects over the entire surface of sheets forming a matrix. Theil teach against the combination with



Art Unit: 1775

Eckart because Theil insist that the decorative object extend over more than 90% of the surface area of the sheets forming the matrix.

Again, the specification does not support the limitations that the decorative object covering substantially more than 90% of the area of the sheets forming the matrix.

As stated in the prior Office action, since the extension of the decorative object at the edge of the matrix was trimmed at the end of the process. The finished solid surface structure would not have the decorative object extends to the edge of the matrix or have the area substantially greater than 90% of the first and second sheets after the extension of the decorative object at the edge of the matrix was trimmed.

### ***Conclusion***

**11. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1775

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling X. Xu whose telephone number is 571-272-1546. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah D. Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ling X. Xu  
Primary Examiner  
Art Unit 1775